

REMARKS

Amendments to the Claims

Applicant amended claims 1, 41, 51, and 75. Applicant believes that basis for these amendments may be found in the specification (for example, see page 67, lines 28-29, page 70, lines 15-18, and the corresponding figures). Accordingly, applicant believes that these amendments do not introduce any new matter.

35 U.S.C. §112

According to the Office Action, claim 40 stands rejected under 35 U.S.C. §112, 2nd paragraph. Applicant amended claim 40 to address this rejection.

35 U.S.C. §102

The Office Action rejected claims 1-3, 6, 7, 9, 16-20, 22, 24-27, 32, 34, 37-46, 75-78, and 80-84 under 35 U.S.C. §102(e) as being anticipated by Sharkey et al (6,379,350). Applicant disagrees.

Claims 1, 51, and 75 have been amended to recite that the resection electrode support is arranged laterally on the shaft. An example of this limitation is shown in Figure 42A. This claim limitation is not shown in the cited references. Accordingly, Applicants request withdrawal of the rejections of these claims.

Claim 41 has also been amended to recite a claim limitation that is not found in the cited references. Claim 41 now recites that the digester electrode is adapted to provide high current density when a voltage is applied thereto. The digester electrode of claim 41 is thus not a return electrode. It is an ablative or active electrode of the device. This claim limitation is not taught or shown in the cited references. Withdrawal of the rejection is therefore requested.

The other claims depend from those discussed above and accordingly are also allowable. Applicant requests withdrawal of this rejection.

35 U.S.C. §103

The Office Action rejected claims 8, 10-14, 23, and 48 under 35 U.S.C. §103(a) as being unpatentable over Sharkey et al. (6,379,350.) The Office Action states that particular structural features of the wire and the particular voltage limitations would have been obvious design expedients to the skilled artisan.

Additionally, the Office Action rejected claims 15, 51-60, 62-65, 68-70, and 85 under 35 U.S.C. §103(a) as being unpatentable over Sharkey et al. (6,379,350) in view of Baker (5,785,705.)

As discussed above, applicant amended claims 1, 41, 51, and 75 from which the rejected claims ultimately depend. No combination of the cited references make up for the shortcomings of Sharkey discussed above in connection with the rejections based on Section 102.

A *prima facie* case of obvious requires amongst other things that all claim limitations are taught or suggested in the prior art references. MPEP § 2143. In the instant case the claim limitations are not taught or suggested by the prior art references set forth in the Office Action.

In view of the above, applicant respectfully requests withdrawal of this rejection.

Allowable Subject Matter

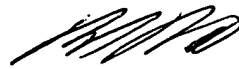
Applicant's attorney wishes to express gratitude to the Examiner for the indication that claims 21, 33, 35, 36, 47, 61, and 79 would be allowable if amended as recited in the Office Action.

Although applicant amended the claims, applicant reserves the right to re-introduce the above claims in independent form prior to the amendments made herein.

IN CLOSING

Applicant believes all outstanding issues raised in the previous Office Action are addressed herein and that the claims are in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 735-6323.

Respectfully submitted,



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